PATENT

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In the Matter of the Application of:	SVEHLA et al.
SERIAL NO.:	10/825,367
Filed:	April 16, 2004
Entitled:	**MANUAL INSERTION TOOL FOR A COCHLEAR IMPLANT**
Docket No.:	22409-00005-US

Group Art Unit: 3731
Examiner: SONNETT, Kathleen.

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APPEAL BRIEF PURSUANT TO 37 C.F.R. § 41.37

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I. REAL PARTY IN INTEREST

The real party in interest is Cochlear Limited of Australia. Cochlear Limited derives its rights in this application by virtue of assignments of the application to Cochlear Limited.

II. RELATED APPEALS AND INTERFERENCES

There are currently no appeals or interferences known to the Appellants, the Appellants' legal representative, or assignee that will directly affect or be directly affected by, or have a bearing on, the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 20-22, 25-37 and 73 are currently pending in the present application, Application Number 10/825,367. Claims 1-19, 23 and 24 were previously cancelled. Claims 38-72 and 74-76 were cancelled in an Amendment filed April 28, 2009. Claims 22-22, 25-37 and 73 have been finally rejected and, therefore, are subject to appeal.

IV. STATUS OF AMENDMENTS

Applicants filed an Amendment after Appeal on April 28, 2009, in which claims 38-72 and 74-76 were cancelled, and in which claims 29 and 34 were amended. In a telephone call conducted on May 11, 2009, the Examiner indicated that an Advisory Action entering these amendments was mailed concurrent to the filing of this Brief. Accordingly, all Amendments have been entered.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Independent claim 20 is directed to a manually adjustable forceps tool 200 for controlling an implantable electrode assembly 108 of a stimulating medical device 102. (*See*, independent claim 20; Specification pg. 6, lns. 22-31, pg. 8, lns. 8-14; FIGS. 2-3C.) Forceps tool 200 comprises: a first flexible arm 204 comprising a first elongate region which is contiguous with a second elongate region 210A, wherein the distal end of the first region is connected to the proximal end of second region 210A. (*See*, independent claim 20; Specification pg. 6, lns. 22-31, pg. 8, lns. 8-14.) A length of second region 210A comprises a concave cross-sectional shaped region 218, wherein the proximal end of concave-shaped cross-sectional region 218 is configured to receive electrode assembly 108 along a longitudinal axis through the geometric center of concave-shaped cross-sectional region 218 and wherein the concave cross-sectional shape enables second region 210A to receive and support the electrode assembly 108 such that relative longitudinal movement of electrode assembly 108 with respect to forceps tool 200 is permitted while relative lateral movement of electrode assembly 108 with respect to forceps tool 200 is substantially restricted. (*See*, independent claim 20; Specification pg. 7, lns. 2-5, pg. 8, lns. 8-14, pg. 9, ln. 18- pg. 10, ln. 9; FIGS. 4A-4C.) Forceps 200 further comprises a second flexible arm 206 comprising a first elongate region which is contiguous with a second elongate region 210B, wherein the distal end of the first region is connected to the proximal end of second region 210B, second region 210B of second arm 206 having a tip region 216, wherein the longitudinal axis is substantially parallel to a longitudinal axis of tip region 216. (*See*, independent claim 20; Specification pg. 6, lns. 22-31, pg. 8, lns. 8-14, pg. 9, lns. 3-18; FIG. 3A and 4B.) The proximal end of the first region of first arm 206 is connected to the proximal end of the first region of second arm 204, and application of a force to at least one of the first regions

causes tip region 216 to travel toward concave cross-sectional shaped region 218, and when tip region 216 is in proximity to concave cross-sectional shaped region 218 electrode assembly 108 is retained in a space defined by concave cross-sectional shaped region 218 and tip region 216, thereby providing operator control of the relative longitudinal movement of electrode assembly 108. (*See*, independent claim 20; Specification, pg. 6, lns. 22-31, pg. 6, ln. 22- pg. 7, ln. 5; FIGS. 3A-3C.)

Independent claim 73 is directed to a manually adjustable forceps tool 200 for controlling an implantable electrode assembly 108 of a stimulating medical device 102. (*See*, independent claim 73; Specification pg. 6, lns. 22-31, pg. 8, lns. 8-14; FIGS. 2-3C.) Forceps tool 200 comprises: a first elongate arm 204 having a longitudinal axis and proximal and distal ends and a structure proximate the distal end that forms at least a portion of a surface of a concave-shaped cross-sectional region 218, wherein the proximal end of concave-shaped cross-sectional region 218 is configured to receive electrode assembly 108 along a longitudinal axis through the geometric center of concave-shaped cross-sectional region 218 and wherein concave-shaped cross-sectional region 218 enables first elongate arm 204 to receive and support electrode assembly 108 such that relative longitudinal movement of electrode assembly 108 with respect to forceps tool 200 is permitted while relative lateral movement of electrode assembly 108 with respect to forceps tool 200 is substantially restricted. (*See*, independent claim 73; Specification pg. 7, lns. 2-5, pg. 8, lns. 8-14, pg. 9, ln. 18- pg. 10, ln. 9; FIGS. 4A-4C.) Forceps tool 200 further comprises a second elongate arm 206 having proximal and distal ends and a tip region 216 disposed proximate to the distal end of second elongate arm 206. (*See*, independent claim 73; Specification pg. 6, lns. 22-31, pg. 8, lns. 8-14, pg. 9, lns. 3-18; FIG. 3A and 4B.) First and second elongate arms 204, 206 are connected to each other such that application of a manual

force to a region adjacent the proximate ends of first and second arms 204, 206 causes tip region 216 and concave-shaped cross-sectional region 218 to travel toward each other to retain electrode assembly 108 in a space between concave-shaped region 218 and tip region 216, thereby providing operator control of the relative longitudinal movement of electrode assembly 108. (*See*, independent claim 73; Specification, pg. 6, lns. 22-31, pg. 6, ln. 22- pg. 7, ln. 5; FIGS. 3A-3C.)

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A. Whether the Examiner improperly rejected independent claims 20 and 73 and dependent claims 21, 22, 25, 27, 35 and 37 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 3,738,366 to Blomberg, (hereinafter, "Blomberg") when Blomberg fails to expressly or inherently disclose all elements of the claimed invention as recited in claims 20-22, 25, 27, 35, 37 and 73.

B. Whether the Examiner improperly rejected independent claims 20 and 73 and dependent claims 21, 22, 25-27, 32 and 37 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,785,810 to Baccala et al., (hereinafter, "Baccala") when Baccala fails to expressly or inherently disclose all elements of the claimed invention as recited in claims 20-22, 25-27, 32, 37 and 73.

C. Whether the Examiner improperly rejected independent claims 20 and 73 and dependent claims 21, 22, 27, 28, 32, 33, 35 and 37 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,759,359 to Willis et al., (hereinafter, "Willis") when Willis fails to expressly or inherently disclose all elements of the claimed invention as recited in claims 20-22, 27, 28, 32, 33, 35, 37 and 73.

D. Whether the Examiner improperly rejected independent claims 20 and 73 and dependent claims 21, 22, 27, 29, 30, 32, 34 and 37 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,464,405 to Fujitsu et al., (hereinafter, "Fujitsu") when Fujitsu fails to expressly or inherently disclose all elements of the claimed invention as recited in claims 20-22, 27, 29, 30, 32, 34, 37 and 73.

E. Whether the Examiner improperly rejected independent claims 20 and 73 and dependent claims 25, 27, 29, 31 and 37 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 1,653,803 to Fisher et al., (hereinafter, "Fisher") when Fisher fails to expressly or inherently disclose all elements of the claimed invention as recited in claims 20, 25, 27, 29, 31, 37 and 73.

F. Whether the Examiner improperly rejected independent claims 20 and 73 and dependent claims 27, 29, 30, 32, 34 and 37 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 2,887,110 to Roeschmann, (hereinafter, "Roeschmann") when Roeschmann fails to expressly or inherently disclose all elements of the claimed invention as recited in claims 20, 27, 29, 30, 32, 34, 37 and 73.

G. Whether the Examiner improperly rejected dependent claims 25 and 26 under 35 U.S.C. §103(a) as being unpatentable over Willis when Willis fails to anticipate or render obvious all elements of the claimed invention.

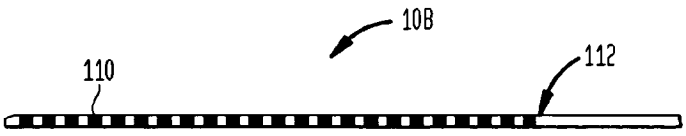
H. Whether the Examiner improperly rejected dependent claim 36 under 35 U.S.C. §103(a) as being unpatentable over Willis in view of U.S. Patent No. 3,815,607 to Chester (hereinafter, "Chester") when the combination of Willis and Chester fails to anticipate or render obvious all elements of the claimed invention.

VII. ARGUMENT

Introduction

Appellants provide below a brief summary of the claimed invention as recited in claims 20 and 73.

FIG. 2



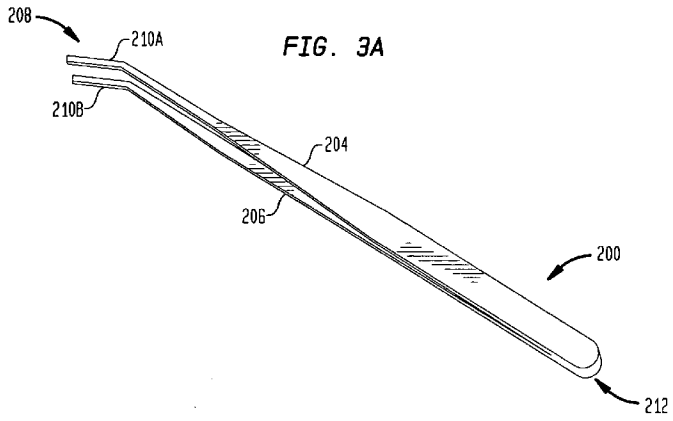


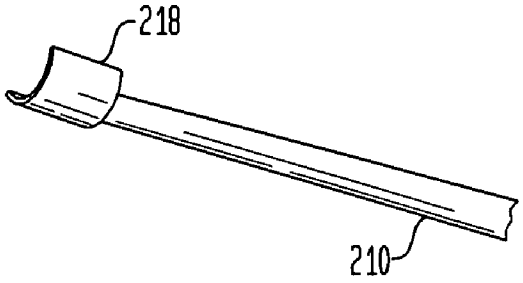
FIG. 3A

Independent claim 20 is directed to a manually adjustable forceps tool 200 configured to receive and control an elongate electrode assembly 108 that is part of a stimulating medical device 102. (*See*, independent claim 20; Specification pg. 6, lns. 22-31, pg. 8, lns. 8-14.) Embodiments of elongate electrode assembly 108 and forceps tool 200 are shown in Appellants' FIGS. 2 and 3A, respectively, reproduced below. As would be appreciated, reproduced FIGS. 2 and 3A are not to scale are merely provided herein for reference.

Forceps tool 200 includes a first flexible arm 204 comprising a first elongate region that is connected to, and contiguous with, a proximal end of a second elongate region 210A. (*See*, independent claim 20; Specification pg. 6, lns. 22-31, pg. 8, lns. 8-14.) A length of second region 210A comprises a region having a concave cross-sectional shape, referred to as region 218. (*See*, independent claim 20; Specification pg. 8, lns. 8-14, pg. 9, ln. 18- pg. 10, ln. 9.) An

embodiment of concave-shaped region 218 is shown in FIG. 4C, reproduced below. As would be appreciated, reproduced FIG. 4C is not to scale.

FIG. 4C



The proximal end of concave cross-sectional shaped region 218 is configured to receive elongate electrode assembly 108 along a longitudinal axis through the geometric center of region 218. (*See*, independent claim 20; Specification pg. 8, lns. 8-14, pg. 9, ln. 18- pg. 10, ln. 9; FIGS. 4A-4C.) In other words, the proximal end of concave cross-sectional shaped region 218 is unobstructed so that the elongate and relatively straight electrode assembly 108 may be inserted into the proximal end of region 218 along the central longitudinal axis of region 218. (*See*, independent claim 20; Specification pg. 8, lns. 8-14, pg. 9, ln. 18- pg. 10, ln. 9; FIGS. 4A-4C.) Once electrode assembly 108 is inserted therein, concave cross-sectional shaped region 218 physically supports elongate electrode assembly 108. (*See*, independent claim 20; Specification pg. 8, lns. 8-14, pg. 9, ln. 18- pg. 10, ln. 9, pg. 7, lns. 2-5.) Furthermore, concave cross-sectional shaped region 218 is sized and shaped such that longitudinal movement of electrode assembly 108 with respect to forceps tool 200 is permitted (under the control of the user), while relative lateral movement of the electrode assembly 108 with respect to forceps tool 200 is substantially restricted. (*See*, independent claim 20; Specification pg. 8, lns. 8-14, pg. 9, ln. 18- pg. 10, ln. 9, pg. 7, lns. 2-5.)

Forceps 200 further includes a second flexible arm 206 comprising a first elongate region that is connected to, and contiguous with, a proximal end of a second elongate region 210B. (*See*, independent claim 20; Specification pg. 6, lns. 22-31, pg. 8, lns. 8-14; FIG. 3A.) Second region 210B comprises a tip region 216 that has a longitudinal axis which is substantially parallel

to the longitudinal axis through the geometric center of region 218. (*See*, independent claim 20; Specification, pg. 9, lns. 3-18.) Furthermore, the proximal ends of arms 204, 206 are connected such that application of a force to at least one of the arms causes tip region 216 to travel toward concave cross-sectional shaped region 218. (*See*, independent claim 20; Specification, pg. 6, lns. 22-31; FIG. 4C.) When tip region 216 is in proximity to concave cross-sectional shaped region 218, elongate electrode assembly 108 is retained in a space defined by concave cross-sectional shaped region 218 and tip region 216, thereby providing operator control of the relative longitudinal movement of electrode assembly 108. (*See*, independent claim 20; Specification, pg. 6, l. 22- pg. 7, l. 5.)

Independent claim 73 is directed to a manually adjustable forceps tool 200 for controlling an implantable electrode assembly 108 of a stimulating medical device 102. (*See*, independent claim 73; Specification pg. 6, lns. 22-31, pg. 8, lns. 8-14; FIGS. 2 and 3A.) Forceps tool 200 includes a first flexible arm 204 having a concave-shaped cross-sectional region 218 disposed at the distal end thereof. (*See*, independent claim 73; Specification pg. 8, lns. 8-14, pg. 9, ln. 18- pg. 10, ln. 9; FIG. 4C.) The proximal end of concave-shaped cross-sectional region 218 is configured to receive electrode assembly 108 along a longitudinal axis through the geometric center of concave-shaped cross-sectional region 218. (*See*, independent claim 73; Specification pg. 8, lns. 8-14, pg. 9, ln. 18- pg. 10, ln. 9; FIGS. 4A-4C.) In other words, the proximal end of concave cross-sectional shaped region 218 is unobstructed so that the elongate and relatively straight electrode assembly 108 may be inserted into the proximal end of region 218 along the central longitudinal axis of region 218. (*See*, independent claim 73; Specification pg. 8, lns. 8-14, pg. 9, ln. 18- pg. 10, ln. 9; FIGS. 4A-4C.) Once electrode assembly 108 is inserted therein, concave cross-sectional shaped region 218 physically supports elongate electrode assembly 108.

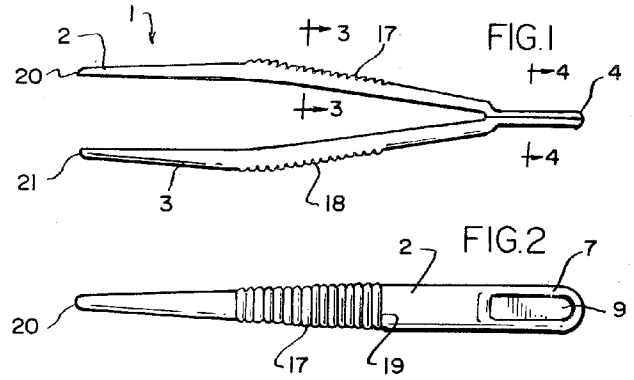
(*See*, independent claim 73; Specification pg. 8, lns. 8-14, pg. 9, ln. 18- pg. 10, ln. 9, pg. 7, lns. 2-5.) Furthermore, concave cross-sectional shaped region 218 is sized and shaped such that longitudinal movement of electrode assembly 108 with respect to forceps tool 200 is permitted, while relative lateral movement of the electrode assembly 108 with respect to forceps tool 200 is substantially restricted. (*See*, independent claim 73; Specification pg. 8, lns. 8-14, pg. 9, ln. 18- pg. 10, ln. 9, pg. 7, lns. 2-5.)

Forceps 200 of claim 73 further includes a second flexible arm 204 having a tip region 216 disposed proximate to the distal end thereof. (*See*, independent claim 73; Specification pg. 6, lns. 22-31, pg. 8, lns. 8-14, pg. 9, lns. 3-18.) The first and second elongate arms 206, 204 are connected to each other such that application of a manual force to a region adjacent the proximate ends of the arms causes tip region 216 and concave-shaped cross-sectional region 218 to travel toward each other to retain electrode assembly 108 in a space between the concave-shaped region and the tip region. (*See*, independent claim 73; Specification, pg. 6, ln. 22- pg. 7, ln. 5.) This provides operator control of the relative longitudinal movement of the electrode assembly. (*See*, independent claim 73; Specification, pg. 6, ln. 22- pg. 7, ln. 5.)

Claim Rejections under 35 U.S.C. §102 in view of Blomberg

As noted, the Examiner has rejected independent claims 20 and 73 and dependent claims 21, 22, 25, 27, 35 and 37 under 35 U.S.C. §102(b) as being anticipated by Blomberg. (*See*, final Office Action, pg. 2.) For at least the reasons set out below, Appellants respectfully assert that these grounds of rejection are improper and should be reversed.

Blomberg is generally directed to disposable forceps comprising a "two-part structure" of two opposing members that may be closed together to perform a "variety of functions" such as removing sutures, handling dressings and cotton balls, manipulating cut or damaged skin, etc.



(*See*, Blomberg, col. 1, lines 7-15., col. 2, ln. 60- col. 3, ln. 15; FIG. 1, reproduced to the left.) Members 2 and 3 each have a U-shaped cross-section and are affixed to one another at end 4. (*See*, Blomberg, FIGS. 1-2; col. 3, lns. 4-53.) Furthermore, as shown in FIGS. 1 and 2, members 2 and 3 are generally parallel to one another and are substantially positioned within a single plane (excluding instrument thickness). (*See*, Blomberg, FIGS. 1-2; col. 2, ln. 60- col. 3, ln. 53.) Within this single plane, each member extends outwardly from end 4 to an intermediate point where the members each begin bend back toward one another. Members 2 and 3 terminate in opposing tips which close together when inward pressure is applied to the members. (*See*, Blomberg, col. 3, ln. 64- col. 4, ln. 6.)

Appellants' claim 20 is directed to a "forceps tool... comprising: a first flexible arm comprising... a concave cross-sectional shaped region, ***wherein the proximal end of said concave-shaped cross-sectional region is configured to receive said electrode assembly along a longitudinal axis through the geometric center of said concave-shaped cross-sectional region***." (*See*, Appellants' claim 20, below; emphasis added.) As noted, opposing members 2 and 3 of Blomberg are affixed to one another at end 4, and extend away from the end within a single plane. (*See*, Blomberg, FIGS. 1-2; col. 2, ln. 60- col. 3, ln. 15.) Because members 2 and 3 are positioned within this single plane, the longitudinal axis through each alleged U-shaped region of Blomberg must extend through one of the members. In other words, in the forceps of Blomberg, the axis through the center of the U-shaped ends is physically obstructed by the members. This physical obstruction of the longitudinal axis makes it impossible for the proximal ends of the U-

shaped regions of Blomberg to receive an elongate and generally straight "electrode assembly ***along a longitudinal axis through the geometric center of said concave-shaped cross-sectional region***" as recited, in part, in Appellants' claim 20. (Emphasis added.) Therefore, for at least this reason, Appellants assert that Blomberg fails to expressly or inherently disclose all elements of Appellants' claim 20. As such, Appellants respectfully request that the rejection of claim 20 as anticipated by Blomberg be reversed.

Appellants' claim 73 is directed to a "forceps tool… comprising: a first elongate arm having a longitudinal axis and proximal and distal ends and a structure proximate said distal end that forms at least a portion of a surface of a concave-shaped cross-sectional region, ***wherein the proximal end of said concave-shaped cross-sectional region is configured to receive the electrode assembly along a longitudinal axis through the geometric center of said concave-shaped cross-sectional region***." (*See*, Appellants' claim 72, below; emphasis added.) For at least the same reason as discussed above with reference to claim 20, Appellants assert that Blomberg fails to expressly or inherently disclose at least these elements of Appellants' claim 73. Specifically, as noted above, the longitudinal axis through the U-shaped forceps members are physically obstructed by the members, thereby making it impossible for the proximal ends of said U-shaped region to receive an elongate "***electrode assembly along a longitudinal axis through the geometric center of said concave-shaped cross-sectional region***" as recited, in part, in Appellants' claim 73. (Emphasis added.) Therefore, Appellants contend that claim 73 is patentable over Blomberg and Appellants respectfully request that the rejection of claim 73 as anticipated by Blomberg be reversed.

Claim Rejections under 35 U.S.C. §102 in view of Baccala

As noted, the Examiner has rejected claims independent claims 20 and 73 and dependent claims 21, 22, 25-27, 32 and 37 under 35 U.S.C. §102(b) as being anticipated by Baccala. (*See*, final Office Action, pg. 4.) For at least the reasons set out below, Appellants respectfully assert that these grounds of rejection are improper and should be reversed.

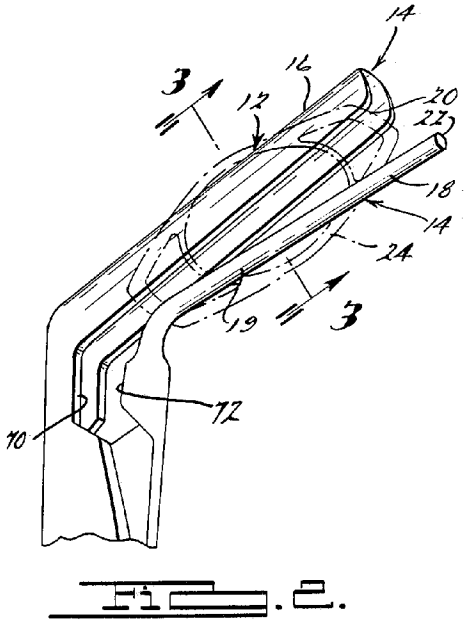


Fig. 2.

Baccala is directed to a surgical instrument used to fold an artificial lens, and then to insert the folded lens into an eye of a patient. (*See*, Baccala, col. 2, lines 39-65.) The instrument of Baccala comprises two actuation arms which terminate in a pair of jaws that perform this function. (*See*, Baccala, col. 3, lines 23-47.) The "first actuation arm is connected to the first elongate jaw" 16 that comprises a U-shaped trough. (*See*, Baccala, col. 5, lns. 30-42; FIG. 2, reproduced above.) The "second actuation arm is provided and connected to the second elongate jaw" 18 which consists of a rod. (*See*, Baccala, col. 5, lns. 30-42; FIG. 2.) As can be seen in FIG. 2, each arm is connected to its respective jaw 16, 18 at an angle such that the arm/jaws form a general L-shape. (*See*, Baccala, col. 5, lns. 30-42; FIG. 2.)

Appellants' claim 20 is directed to a "forceps tool... comprising: a first flexible arm comprising... a concave cross-sectional shaped region, ***wherein the proximal end of said concave-shaped cross-sectional region is configured to receive said electrode assembly along a longitudinal axis through the geometric center of said concave-shaped cross-sectional region***." (*See*, Appellants' claim 20, above; emphasis added.) As noted, each arm of Baccala is connected

to a jaw so that each arm/jaw collectively form a general L-shape. (*See*, Baccala, col. 5, lns. 30-42; FIGS. 1-2.) Due to this L-shape, the longitudinal axis through the U-shaped trough of the first elongate jaw must extend through one of the arms. In other words, the L-shape results in the physical obstruction of the longitudinal axis through the center of the U-shaped trough. This physical obstruction makes it impossible for the proximal end of the U-shaped trough to receive an elongate and straight "***electrode assembly along a longitudinal axis through the geometric center of said concave-shaped cross-sectional region***" as recited, in part, in Appellants' claim 20. (Emphasis added.) For at least this reason, Appellants assert that Baccala fails to expressly or inherently disclose all elements of Appellants' claim 20. Appellants respectfully request that the rejection of claim 20 as anticipated by Baccala be reversed.

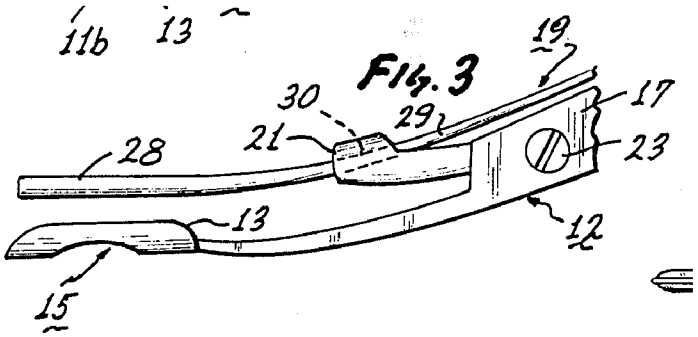
Appellants' claim 73 is directed to a "forceps tool… comprising: a first elongate arm having a longitudinal axis and proximal and distal ends and a structure proximate said distal end that forms at least a portion of a surface of a concave-shaped cross-sectional region, ***wherein the proximal end of said concave-shaped cross-sectional region is configured to receive the electrode assembly along a longitudinal axis through the geometric center of said concave-shaped cross-sectional region***." (*See*, Appellants' claim 72, below; emphasis added.) For at least the same reason as discussed above with reference to claim 20, Appellants assert that Baccala fails to expressly or inherently disclose at least these elements of Appellants' claim 73. Specifically, as described above, the longitudinal axis through the U-shaped trough of Baccala is physically obstructed making it impossible for the proximal end of the U-shaped portion to receive an elongate electrode assembly "***along a longitudinal axis through the geometric center of said concave-shaped cross-sectional region***" as recited, in part, in Appellants' claim 73. (Emphasis added.) Therefore, Appellants assert that claim 73 is patentable over Baccala and

Appellants respectfully request that the rejection of claim 73 as anticipated by Baccala be reversed.

Claim Rejections under 35 U.S.C. §102 in view of Willis

As noted, the Examiner has rejected independent claims 20 and 73 and dependent claims 21, 22, 27, 28, 32, 33, 35 and 37 under 35 U.S.C. §102(b) as being anticipated by Willis. (*See*, final Office Action, pg. 5.) For at least the reasons set out below, Appellants respectfully assert that these grounds of rejection are improper and should be reversed.

Willis is directed to a "lens implantation instrument [which] includes first and second prongs connected together in a forceps-like configuration." (*See*, Willis, Abstract; col. 2, lns. 3-28; FIG. 3, reproduced below.)



The first prong is an elongate member 12 which comprises a handle 16, a distal portion that "defines a concave channel or trough 14," and an intermediate portion 17 connecting the trough to the handle. (*See*, Willis, col. 3, lns. 19-59; FIGS. 3-6.) The second prong includes a handle connected to an elongate element 19 terminating in "a distal end portion [28] that extends generally parallel to the trough… [and] has a size and shape adapted to fit at least partially into the trough." (*See*, Willis, col. 2, lns. 3-28; FIG. 3.)

Appellants' claim 20 is directed to a "forceps tool… comprising: a first flexible arm comprising… a concave cross-sectional shaped region, ***wherein the proximal end of said concave-shaped cross-sectional region is configured to receive said electrode assembly along a***

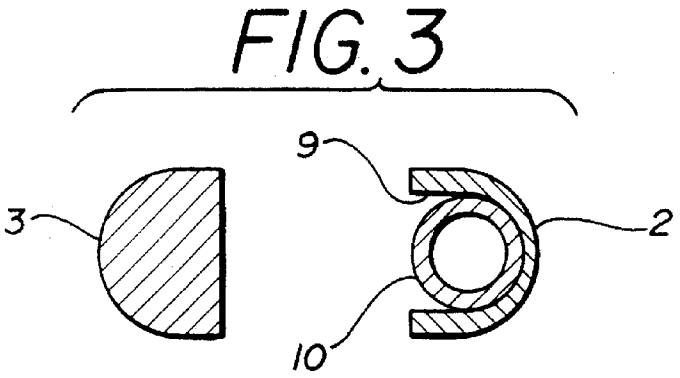
longitudinal axis through the geometric center of said concave-shaped cross-sectional region." (*See*, Appellants' claim 20, below; emphasis added.) As noted, intermediate portion 17 of the first prong of Willis extends from trough 14 to handle 16. (*See*, Willis, col. 3, lns. 19-59.) As can be seen in FIGS. 1-3, the longitudinal axis through trough 14 must extend through intermediate portion 17. In other words, the longitudinal axis through the center of trough 14 is physically obstructed near its proximal end by intermediate portion 17. This physical obstruction makes it impossible for the proximal end of trough 14 to receive an elongate "***electrode assembly along a longitudinal axis through the geometric center of said concave-shaped cross-sectional region***" as recited, in part, in Appellants' claim 20. (Emphasis added.) Therefore, for at least this reason, Appellants assert that Willis fails to expressly or inherently disclose all elements of Appellants' claim 20. As such, Appellants respectfully request that the rejection of claim 20 as anticipated by Willis be reversed.

Appellants' claim 73 is directed to a "forceps tool… comprising: a first elongate arm having a longitudinal axis and proximal and distal ends and a structure proximate said distal end that forms at least a portion of a surface of a concave-shaped cross-sectional region, ***wherein the proximal end of said concave-shaped cross-sectional region is configured to receive the electrode assembly along a longitudinal axis through the geometric center of said concave-shaped cross-sectional region***." (*See*, Appellants' claim 77, below; emphasis added.) For at least the same reason as discussed above with reference to claim 20, Appellants assert that Willis fails to expressly or inherently disclose at least these elements of Appellants' claim 73. Specifically, as noted above, the longitudinal axis through the trough of Willis is physically obstructed making it impossible to receive an electrode assembly "***along a longitudinal axis through the geometric center of said concave-shaped cross-sectional region***" as recited, in part,

in Appellants' claim 73. (Emphasis added.) Therefore, Appellants assert that claim 73 is patentable over Willis and Appellants respectfully request that the rejection of claim 73 as anticipated by Willis be reversed.

Claim Rejections under 35 U.S.C. §102 in view of Fujitsu

As noted, the Examiner has rejected independent claims 20 and 73 and dependent claims 21, 22, 27, 29, 30, 32, 34 and 37 under 35 U.S.C. §102(b) as being anticipated by Fujitsu. (*See*, final Office Action, pg. 6.) For at least the reasons set out below, Appellants respectfully assert that these grounds of rejection are improper and should be reversed.



Fujitsu is directed to a pair of "bipolar electric coagulating and incising tweezers." (*See*, Fujitsu, col. 1, lns. 51-55.) The tweezers comprise first and second arms 2 and 3 each having a tip portion 8 and a grip portion 4. (*See*, Fujitsu, col. 1, lns. 40-49; FIG. 1.) Grip portions 4 are connected together at their proximal end, and tip portions 8 are configured to be closed together to incise a tissue. (*See*, Fujitsu, FIG. 1, col. 2, ln. 40- col. 3, ln. 15.) Tip portions 8 are each connected to electrodes to assist in coagulation following incising of tissue. (*See*, Fujitsu, col. 1, lns. 9-27.) The tweezers of Fujitsu have the added feature that a perfusion passage pipe 10 is embedded in a groove 9 in the surface of one of the arms. (*See*, Fujitsu, col. 2, ln. 40- col. 3, ln. 15; FIG. 3, reproduced above.) Perfusion passage pipe 10 permits the flow of a saline or other liquid there through during the incising procedure. (*See*, Fujitsu, col. 1, lns. 9-27.)

Appellants' claim 20 is directed to a "forceps tool… comprising: a first flexible arm comprising… a concave cross-sectional shaped region… a second flexible arm comprising… a tip region, wherein… ***when said tip is in proximity to said concave cross-sectional shaped region said electrode assembly is retained in a space defined by said concave cross-sectional shaped region and said tip region***, thereby providing operator control of the relative longitudinal movement of said electrode assembly." (*See*, Appellants claim 20, above; emphasis added.) In the outstanding Office Action, the Examiner asserts that perfusion passage pipe 10 could support an electrode assembly, and thus Fujitsu teaches the above elements of claim 20. (*See*, final Office Action, pg. 7.) Appellants respectfully disagree.

Even if an electrode assembly was held in the perfusion passage pipe 10 as asserted by the Examiner (which it is not), the other tip would not retain the electrode array "in a space defined by said concave cross-sectional shaped region and said tip region, thereby providing operator control of the relative longitudinal movement of said electrode assembly" as recited, in part, in claim 20. Rather, as noted above, tip portions 8 are designed to only close together at their distal ends so as to incise tissue through the use of high-frequency current. (*See*, Fujitsu, col. 1, lns. 9-27.) As would be appreciated, in order for tips portions 8 to close, perfusion passage pipe 10 must stop well before the distal end of arm 2. (*See*, Fujitsu, FIG. 1.) Therefore, because perfusion passage pipe 10 stops prior to the distal end where tip portions 8 close together, Appellants assert that it is impossible for the tip portions to retain an electrode assembly in the alleged "***concave cross-sectional shaped region"*** (i.e. the perfusion passage pipe) and to provide any type of "operator control" of the longitudinal movement of the electrode assembly within the passage pipe.

Appellants' claim 20 is further directed to a "forceps tool… comprising: a first flexible arm comprising… a concave cross-sectional shaped region, ***wherein the proximal end of said concave-shaped cross-sectional region is configured to receive said electrode assembly along a longitudinal axis through the geometric center of said concave-shaped cross-sectional region***." (*See*, Appellants' claim 20, above; emphasis added.) As shown in FIG. 2 of Fujitsu, perfusion passage pipe 10 extends along a portion of arm 2 and terminates at a "perfusion connection port 11 within a housing" where it connected to a "perfusing device." (*See*, Fujitsu, col. 2, lns. 50-66; FIG. 2.) Due to the fact that the proximal end of the structure that the Examiner contends is able to support an electrode assembly is physically blocked by a "perfusing device," Appellants assert that it is impossible for the proximal end of perfusion passage pipe 10 to receive an electrode assembly "***along a longitudinal axis through the geometric center of said concave-shaped cross-sectional region***" as recited, in part, in Appellants' claim 20. (Emphasis added.)

For at least these reasons, Appellants assert that the tweezers of Fujitsu fail to expressly or inherently disclose all elements of Appellants' invention as recited in claim 20. As such, Appellants respectfully request that the rejection of claim 20 as anticipated by Fujitsu be reversed.

Appellants' claim 73 is directed to a "a "forceps tool…comprising: a first elongate arm having... a concave-shaped cross-sectional region…and a second elongate arm having…a tip region… [configured] to retain the electrode assembly in a space between said concave-shaped region and said tip region, thereby ***providing operator control of the relative longitudinal movement of the electrode assembly***." (*See*, Appellants' claim 73, below; emphasis added.) For at least the same reasons as discussed above with reference to claim 20, Appellants assert that Fujitsu fails to expressly or inherently disclose at least these elements of Appellants' claim

73. Specifically, the alleged concave portion of Fujitsu includes a perfusion pipe which, according to the Examiner, is configured to receive the electrode assembly. (*See*, final Office Action, pg. 7.) However, as noted above, even if this is correct, (which Appellants contend is not a reasonable interpretation of Fujitsu), Appellants assert that the pipe ends well before the location at which other tip of Fujitsu would contact the tip, thus preventing any retention of the electrode assembly within the pipe and any "***operator control of the relative longitudinal movement of the electrode assembly***" as recited, in part, in Appellants' claim 73. (Emphasis added.)

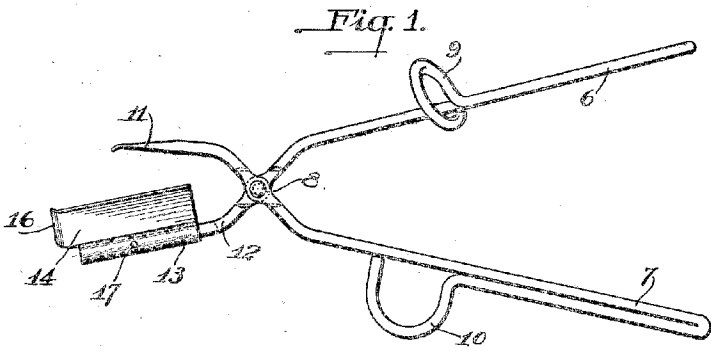
Appellants' claim 73 is directed to a "forceps tool… comprising: a first elongate arm having a longitudinal axis and proximal and distal ends and a structure proximate said distal end that forms at least a portion of a surface of a concave-shaped cross-sectional region, ***wherein the proximal end of said concave-shaped cross-sectional region is configured to receive the electrode assembly along a longitudinal axis through the geometric center of said concave-shaped cross-sectional region***." (*See*, Appellants' claim 73, below; emphasis added.) For at least the same reasons as discussed above with reference to claim 20, Appellants assert that Fujitsu fails to expressly or inherently disclose at least these elements of Appellants' claim 73. Specifically, as noted above, the proximal end of the perfusion passage is physically blocked by a "perfusing device" making it impossible to receive an electrode assembly "along a longitudinal axis through the geometric center of said concave-shaped cross-sectional region" as recited, in part, in Appellants' claim 73.

For at least the above reasons, Appellants assert that claim 73 is patentable over Fujitsu. Therefore, Appellants respectfully request that the rejection of claim 73 as anticipated by Fujitsu be reversed.

Claim Rejections under 35 U.S.C. §102 in view of Fisher

As noted, the Examiner has rejected independent claims 20 and 73 and dependent claims 25, 27, 29, 31 and 37 under 35 U.S.C. §102(b) as being anticipated by Fisher. (*See*, final Office Action, pg. 8.) For at least the reasons set out below, Appellants respectfully assert that these grounds of rejection are improper and should be reversed.

Fisher is directed to a pair of laboratory tongs designed to hold the handles of laboratory dishes, commonly referred to as casseroles. (*See*, Fisher, pg. 1, lns. 1-13.) The tongs "comprise two handle members [6 and 7] joined by a rivet" 8. (*See*, Fisher, pg. 1, lns. 51-52; FIG. 1, reproduced below.)



The distal end of handle 7 comprises a "flat broadened terminal portion 11, which is adapted to seat upon and engage the upper flattened face 3 of the handle of a casserole." (*See*, Fisher, pg. 1, lns. 75-79; FIG. 1) The distal end 12 of the handle 6 terminates in an elongate plate member. (*See*, Fisher, pg. 1, lns. 80-90; FIG. 1.) A cylindrical member 13 surrounds the elongate plate member and is secured thereto by rivets. (*See*, Fisher, pg. 1, lns. 80-90; FIG. 1.) Two wings 14 and 15 extend from this cylindrical member towards the "flat broadened terminal portion" of the other handle. (*See*, Fisher, pg. 1, lns. 80-90; FIG. 1.) Each of these wing members has a inwardly extending terminal flange 16 at its end. (*See*, Fisher, pg. 1, lns. 80-90; FIG. 1.) Both handles are positioned in a single plane (excluding handle thickness) "that passes between the flat faces connected by the rivet. (*See*, Fisher, pg. 1, lns. 70-75; FIG. 1.)

As further recited in Fisher, "when these tongs are used for gripping the handle of a casserole… the broad flattened straight-edged portion of the upper tong member seats upon and grips" the upper flat surface of the casserole handle. (*See*, Fisher, pg. 1, lns. 90-101; FIG. 1.) "At the same time the trough-like jaw formed by the wings engages the two under sides of the rounded portion of the handle, while the flanges… extend into and seat in" a groove in the handle. (*See*, Fisher, pg. 1, lns. 90-101; FIG. 2.)

Appellants' claim 20 is directed to a "forceps tool… comprising: a first flexible arm comprising… a concave cross-sectional shaped region… wherein said concave cross-sectional shape enables said second region to receive and support said electrode assembly." As described above, the tongs of Fisher comprise an end portion having wings terminating in "inturned terminal flanges." (*See*, Fisher, pg. 1, lns. 80-90.) As would be appreciated, because of these "inturned terminal flanges" the tongs of Fisher would be unable to "to receive and support said electrode assembly" as recited in claim 20.

Appellants' claim 20 is further directed to a "forceps tool… comprising: a first flexible arm comprising… a concave cross-sectional shaped region, ***wherein the proximal end of said concave-shaped cross-sectional region is configured to receive said electrode assembly along a longitudinal axis through the geometric center of said concave-shaped cross-sectional region***." (*See*, Appellants' claim 20, above; emphasis added.) As noted, the handle members of Fisher are affixed to one another via a central rivet, and are both positioned substantially in a single plane. (*See*, Fisher, pg. 1, lns. 70-75.) Due to the fact that the handles of Fisher are entirely positioned in this single plane, the longitudinal axis through the trough-like portion would extend through one of the handles. In other words, the longitudinal axis is physically obstructed at all times by one of the handles. Due to this physical obstruction, it would be impossible for the tongs of

Fisher to receive an elongate electrode assembly "***along a longitudinal axis through the geometric center of said concave-shaped cross-sectional region***" as recited, in part, in Appellants' claim 20. (Emphasis added.) Therefore, Appellants assert that Fisher fails to expressly or inherently disclose all elements of claim 20. As such, Appellants respectfully request that the rejection of claim 20 as anticipated by Fisher be reconsidered, and that it be withdrawn.

Appellants' claim 73 is directed to a "forceps tool… comprising: a first elongate arm having a longitudinal axis and proximal and distal ends and a structure proximate said distal end that forms at least a portion of a surface of a concave-shaped cross-sectional region, ***wherein the proximal end of said concave-shaped cross-sectional region is configured to receive the electrode assembly along a longitudinal axis through the geometric center of said concave-shaped cross-sectional region***." (*See*, Appellants' claim 73, below; emphasis added.) For at least the same reasons as discussed above with reference to claim 20, Appellants assert that Fisher fails to expressly or inherently disclose at least these elements of Appellants' claim 73. Specifically, as noted above, the longitudinal axis through the alleged concave region of Fisher is physically obstructed making it impossible to receive an electrode assembly "along a longitudinal axis through the geometric center of said concave-shaped cross-sectional region" as recited, in part, in Appellants' claim 73. Therefore Appellants assert that claim 73 is patentable over Fisher and Appellants respectfully request that the rejection of claim 73 as anticipated by Fisher be reversed.

Claim Rejections under 35 U.S.C. §102 in view of Roeschmann

As noted, the Examiner has rejected independent claims 20 and 73 and dependent claims 27, 29, 30, 32, 34 and 37 under 35 U.S.C. §102(b) as being anticipated by Roeschmann. (*See*, final Office Action, pg. 9.) For at least the reasons set out below, Appellants respectfully assert that these grounds of rejection are improper and should be reversed.

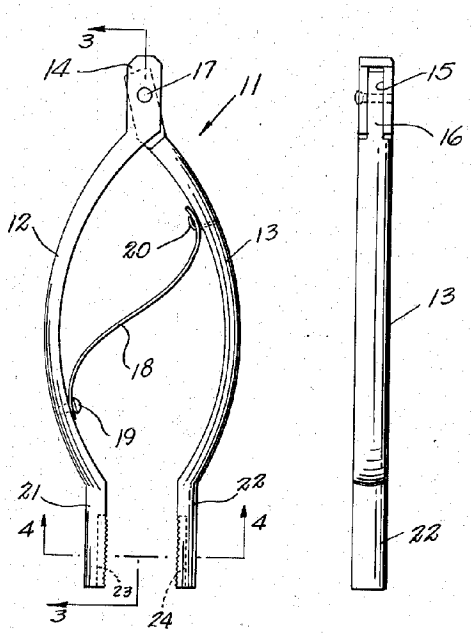


FIG. 1. FIG. 2.

Roeschmann is directed to forceps for removing surgical clips or clamps. (*See*, Roeschmann, col. 1, lns. 14-23.) The forceps comprise "a pair of outwardly bowed arms" 12 and 13 pivotally connected together at one end. (*See*, Roeschmann, col. 1, lns. 50-67; FIG. 1, reproduced to the left.) The other ends of arms 12 and 13 comprise a pair of parallel fingers 21 and 22, respectively. (*See*, Roeschmann, col. 1, ln. 67- col. 2, ln. 10; FIG. 1.) As shown in FIG. 1, each finger has a longitudinal groove 23, 24 that extends partially along the face thereof. (*See*, Roeschmann, FIG. 1; col. 1, ln. 67- col. 2, ln. 10.) Furthermore, as shown in FIG. 2, arms 12 and 13 are positioned parallel in a single plane (not including instrument thickness) such that as the arms are squeezed together, fingers 21 and 22 are also brought together and a portion of a surgical clip is received in each of the grooves 23, 24. (*See*, Roeschmann, col. 2, lns. 11-34; FIG. 2, reproduced to the left.) Fingers 21 and 22 then firmly grip the surgical clip so that it may be removed from a patient. (*See*, Roeschmann, col. 2, lns. 11-34.)

Appellants' claim 20 is directed to a "forceps tool… comprising: a first flexible arm comprising… a concave cross-sectional shaped region, ***wherein the proximal end of said concave-shaped cross-sectional region is configured to receive said electrode assembly along a longitudinal axis through the geometric center of said concave-shaped cross-sectional region***." (*See*, Appellants' claim 20, above; emphasis added.) As noted, the arms of Roeschmann are connected to one another via a pivot, and are both positioned in a single plane. (*See*, Roeschmann, col. 1, lns. 50-67.) Due to the fact that the arms of Roeschmann are entirely positioned in this single plane, the longitudinal axis through the longitudinal grooves would extend through at least one of the arms. In other words, the longitudinal axis is physically obstructed making it impossible for the proximal end of the grooves of Roeschmann to receive an elongate electrode assembly "***along a longitudinal axis through the geometric center of said concave-shaped cross-sectional region***" as recited, in part, in Appellants' claim 20. (Emphasis added.) Therefore, Appellants assert that Roeschmann fails to expressly or inherently disclose all elements of claim 20. As such, Appellants respectfully request that the rejection of claim 20 as anticipated by Roeschmann be reconsidered, and that it be withdrawn.

Appellants' claim 73 is directed to a "forceps tool… comprising: a first elongate arm having a longitudinal axis and proximal and distal ends and a structure proximate said distal end that forms at least a portion of a surface of a concave-shaped cross-sectional region, ***wherein the proximal end of said concave-shaped cross-sectional region is configured to receive the electrode assembly along a longitudinal axis through the geometric center of said concave-shaped cross-sectional region***." (*See*, Appellants' claim 73, below; emphasis added.) For at least the same reason as discussed above with reference to claim 20, Appellants assert that Roeschmann fails to expressly or inherently disclose at least these elements of Appellants' claim

73. Specifically, as noted above, the longitudinal axis through the alleged concave region of Roeschmann is physically obstructed making it impossible to receive an electrode assembly "along a longitudinal axis through the geometric center of said concave-shaped cross-sectional region" as recited, in part, in Appellants' claim 73. Therefore, Appellants assert that claim 73 is patentable over Roeschmann and Appellants respectfully request that the rejection of claim 73 as anticipated by Roeschmann be reversed.

Claim Rejections under 35 USC § 103 in view of Willis

As noted, the Examiner has rejected dependent claims 25 and 26 under 35 U.S.C. §103(a) as being unpatentable over Willis. Appellants respectfully assert that for at least the reasons discussed above with reference to the rejection of claim 20 under 35 U.S.C. §102, Willis fails to anticipate or render obvious that which is asserted by the Examiner. Specifically, Willis fails to anticipate or render obvious a "forceps tool… comprising: a first flexible arm comprising… a concave cross-sectional shaped region, ***wherein the proximal end of said concave-shaped cross-sectional region is configured to receive said electrode assembly along a longitudinal axis through the geometric center of said concave-shaped cross-sectional region***." (*See*, Appellants' claim 20, below; emphasis added.) As such, Appellants respectfully request that the rejection of claims 25 and 26 as unpatentable over Willis be reversed.

Claim Rejections under 35 USC § 103 in view of Willis and Chester

As noted, the Examiner has rejected dependent claim 36 under 35 U.S.C. §103(a) as being unpatentable over Willis in view of Chester. Appellants respectfully assert that for at least the reasons discussed above with reference to the rejection of claim 20 under 35 U.S.C. §102, Willis fails to anticipate or render obvious that which is asserted by the Examiner. Specifically,

Willis fails to anticipate or render obvious a "forceps tool… comprising: a first flexible arm comprising… a concave cross-sectional shaped region, ***wherein the proximal end of said concave-shaped cross-sectional region is configured to receive said electrode assembly along a longitudinal axis through the geometric center of said concave-shaped cross-sectional region***." (*See*, Appellants' claim 20, below; emphasis added.) Appellants assert that Chester fails to anticipate or render obvious that which is missing from Willis. As such, Appellants respectfully request that the rejection of claim 36 as unpatentable over Willis in view of Chester be reversed.

VIII. CONCLUSION

For the reasons noted above, Appellants submit that the pending claims define patentable subject matter. Accordingly, Appellants request that the Examiner's rejections of these claims be reversed and that the pending application be passed to issue.

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Respectfully submitted,

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CLAIMS APPENDIX

20. A manually adjustable forceps tool for controlling an implantable electrode assembly of a stimulating medical device comprising:

a first flexible arm comprising contiguous first and second elongate regions, wherein the distal end of said first region is connected to the proximal end of said second region, a length of said second region comprising a concave cross-sectional shaped region, wherein the proximal end of said concave-shaped cross-sectional region is configured to receive said electrode assembly along a longitudinal axis through the geometric center of said concave-shaped cross-sectional region and wherein said concave cross-sectional shape enables said second region to receive and support said electrode assembly such that relative longitudinal movement of said electrode assembly with respect to the forceps tool is permitted while relative lateral movement of said electrode assembly with respect to the forceps tool is substantially restricted; and

a second flexible arm comprising first and second contiguous elongate regions, wherein the distal end of said first region is connected to the proximal end of said second region, said second region of said second arm having a tip region, wherein said longitudinal axis is substantially parallel to a longitudinal axis of said tip region, and

wherein said proximal end of said first region of said first arm is connected to the proximal end of said first region of said second arm, and wherein application of a force to at least one of said first regions causes said tip region to travel toward said concave cross-sectional shaped region, and when said tip is in proximity to said concave cross-sectional shaped region said electrode assembly is retained in a space defined by said concave cross-sectional shaped region and said tip region, thereby providing operator control of the relative longitudinal movement of said electrode assembly.

21. The forceps of claim 20, wherein said concave cross-sectional shaped -region comprises:

a region having a substantially C-shaped cross-section.

22. The forceps of claim 21, wherein said C-shaped region comprises:

a region having a substantially half-tube shaped cross-section.

25. The forceps of claim 20, wherein said second regions of said first and second arms are each positioned at an angle of approximately 0° to 25° degrees from said first regions of said respective first and second arms.

26. The forceps of claim 25, wherein said second regions are each positioned at an angle of approximately 18 degrees from said first regions of said respective first and second arms.

27. The forceps of claim 20, wherein a line through the center of the space defined by said concave cross-sectional shaped second region is substantially aligned with the longitudinal axis of said second region of said first arm.

28. The forceps of claim 20, wherein said concave cross-sectional shape further comprises:

an aperture positioned at the trough of said concave cross-sectional shape.

29. The forceps of claim 20, wherein said tip region comprises:

a region having an approximately half-circular shaped cross-section including a flat surface, wherein the flat surface of said half-circular shape is proximate to said concave cross-sectional shaped region when said tip region is in proximity to said concave cross-sectional shaped region.

30. The forceps of claim 29, wherein the flat surface of said tip region has a width that is greater than the width of the space defined by said concave cross-sectional shaped region.

31. The forceps of claim 29, wherein the flat surface of said tip region has a width that is less than the width of the space defined by said concave cross-sectional shaped region.

32. The forceps of claim 20, wherein said tip region extends the length of said second region of said second arm, and comprises:

an approximately constant cross-section.

33. The forceps of claim 32, wherein said tip region comprises:

a substantially rectangular cross-section.

34. The forceps of claim 32, wherein said tip region comprises:

a region having an approximately half-circular shaped cross-section including a flat surface, wherein the flat surface of said half-circular shape is proximate to said concave cross-sectional shaped region when said tip region is in proximity to said concave cross-sectional shaped region.

35. The forceps of claim 20, wherein said distal ends of said second regions move towards each other when said arms are compressed, and wherein said distal ends of said second regions move away from each other when the compression is released.

36. The forceps of claim 20, wherein one of said arms includes a post positioned on said arm, said post being proximate to the other of said arms when said tip region is in proximity to said concave region, and wherein said post is configured to prevent said tip region from contacting said concave region.

37. The forceps of claim 20, wherein said electrode array comprises an electrode array selected from the group of: a cochlea stimulation electrode array, a spinal stimulation electrode array or an auditory midbrain stimulation array.

73. A manually adjustable forceps tool for controlling an implantable electrode assembly of a stimulating medical device comprising:

a first elongate arm having a longitudinal axis and proximal and distal ends and a structure proximate said distal end that forms at least a portion of a surface of a concave-shaped cross-sectional region, wherein the proximal end of said concave-shaped cross-sectional region is configured to receive the electrode assembly along a longitudinal axis through the geometric center of said concave-shaped cross-sectional region and wherein said concave-shaped cross-sectional region enables said first elongate arm to receive and support the electrode assembly such that relative longitudinal movement of the electrode assembly with respect to the forceps tool is permitted while relative lateral movement of the electrode assembly with respect to the forceps tool is substantially restricted; and

a second elongate arm having proximal and distal ends and a tip region disposed proximate to said distal end of said second elongate arm,

wherein said first and second elongate arms are connected to each other such that application of a manual force to a region adjacent said proximate ends of said first and second arms causes said tip region and said concave-shaped cross-sectional region to travel toward each other to retain the electrode assembly in a space between said concave-shaped region and said tip region, thereby providing operator control of the relative longitudinal movement of the electrode assembly.

EVIDENCE APPENDIX

None

RELATED PROCEEDINGS APPENDIX

None